

REMARKS

This paper is responsive to the Office Action mailed August 25, 2005. In the Office Action, the Examiner identified new grounds for rejecting Claims 1-20 under 35 U.S.C. § 102(b) and § 103(a) as being anticipated or obvious in view of certain "Consumer Reports webpages" detailing an online service; U.S. Patent No. 6,802,000 to Greene et al.; U.S. Patent No. 6,385,614 to Vellandi; and U.S. Patent No. 6,331,865 to Sachs et al. Applicant has amended Claims 1, 16-18, and 20, and added new Claims 21-28 as indicated above. Claims 1-28 are pending in the application.

Examiner Desire is thanked for the time and consideration he extended in a telephone interview conducted October 6, 2005. In the interview, the undersigned counsel and Examiner Desire discussed the cited references in view of pending Claims 1-20. In particular, the deficiencies of the Consumer Reports webpages relative to the pending claims were noted. These deficiencies, as will be discussed below, are not overcome by the citations to Greene, Vellandi, and/or Sachs. None of these references teach or suggest providing access to page images of a physical text based on the user's ownership of the physical text. For this reason among others, the claims in the present application are patentable over the prior art. Applicants respectfully request reconsideration and allowance of the application.

The Consumer Reports webpages are directed to an online service ("*Consumer Reports Online*") to which Internet users can subscribe for a fee. All users who pay the annual fee associated with *Consumer Reports Online* are provided access to all of the content at the *Consumer Reports Online* website. Importantly, for purposes of access to content at the *Consumer Reports Online* website, no distinction is made between users who subscribe to the Consumer Reports magazine and those who do not.

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The Examiner has highlighted a feature in which subscribers to Consumer Reports magazine are entitled to special pricing for the annual fee to *Consumer Reports Online*. The special pricing is available to users who submit a "22-digit code" found on their magazine mailing label. Nevertheless, it is evident from the cited webpages that Consumer Reports magazine subscribers do not receive any more or any less of the content at the *Consumer Reports Online* website as opposed to non-subscribers of the magazine. Rather, submission of the 22-digit code found on the magazine mailing label merely entitles Consumer Reports magazine subscribers to a reduced annual fee.

The method recited in Claim 1 of the present application is patentably distinguishable over the Consumer Reports webpages cited in the Office Action. Claim 1 is directed to a method for providing user access to electronic images of a physical text based on user ownership of the physical text. In part, Claim 1 recites "consulting one or more access rules that define an amount of content in electronic images of the physical text that can be provided to the user based on the user's ownership of the physical text, wherein the defined amount of content for users who own the physical text is greater than an amount of content that may otherwise be provided to users who do not own the physical text."

First, the cited Consumer Reports webpages do not teach "consulting one or more access rules that define an amount of content in electronic images of the physical text that can be provided to the users *based on the user's ownership of the physical text*." (Emphasis added). The Examiner has suggested that the Consumer Reports webpages inherently teach "defining an amount of content" in that Consumer Reports magazine subscribers are entitled to all of the content at the *Consumer Reports Online* website. However, this ignores the claim limitation in which the amount of content is defined based on the user's ownership of the physical text. Where the same amount of content (that is, all of the *Consumer Reports Online* website) is

equally available to subscribers (owners) and non-subscribers (non-owners) of Consumer Reports magazine, the Consumer Reports webpages cannot be interpreted as "consulting one or more access rules that define an amount of content in electronic images of the physical text that can be provided to the user based on the user's ownership of the physical text."

According to the cited webpages, user input of a Consumer Reports magazine code has nothing to do with defining an amount of content that will be provided to the user. In other words, there is no connection between user subscription to the magazine and the amount of content that is accessible at the *Consumer Reports Online* website. The magazine code is used only to obtain special pricing on the annual fee. Once the annual fee is paid, magazine subscribers and non-subscribers alike have access to the same amount of content at the *Consumer Reports Online* website.

Second, it should be further recognized that the Consumer Reports webpages do not teach or suggest the claim element "wherein the defined amount of content for users who own the physical text is greater than an amount of content that may otherwise be provided to users who do not own the physical text." This deficiency in the cited Consumer Reports webpages is evident from review of the webpages and the discussion provided above. Further, the Greene, Vellandi, and Sachs references do not cure this deficiency in the cited webpages, nor were these references cited or applied by the Examiner with respect to Claim 1. Careful review of the Greene, Vellandi, and Sachs references confirms that a *prima facie* rejection of Claim 1 cannot be maintained using the secondary references because the references, alone or in combination with the Consumer Reports webpages, fail to teach the combination of all the elements of Claim 1.

Accordingly, Claim 1 is distinguishable over the prior art and should be allowed. Claims 2-11, which have not been amended, are also allowable for their dependence on Claim 1 and for the additional subject matter recited therein.

Claim 12 is directed to a method for providing a central database with electronic images of physical texts and enabling access thereto by multiple users. The method in Claim 12 comprises, in part, "enabling the user to access page images of the particular physical text in the central database based on the user's ownership of the physical text." The cited Consumer Reports webpages do not teach or suggest this element of Claim 12. User submission of a magazine subscriber code has nothing to do with the user's ability to access content at the *Consumer Reports Online* website; it only entitles the magazine subscriber to a reduced annual fee. The *Consumer Reports Online* website does not enable a user to access to page images of a particular physical text based on the user's ownership of the physical text. Rather, to the extent that *Consumer Reports Online* is argued to provide access to page images of a physical text (which applicants deny, as such argument is not supported by the cited webpages), it only does so based on the user's payment of the annual fee -- not based on the user's ownership of the physical text.

Claim 12 is therefore distinguishable over the cited Consumer Report webpages. As with Claim 1, the deficiencies of the Consumer Reports webpages are not overcome by the secondary references to Greene, Vellandi, and Sachs. The secondary references were not cited or applied by the Examiner with respect to Claim 12. Careful review of the secondary references confirms that the Patent Office cannot maintain a *prima facie* rejection of Claim 12 using the secondary references, even if combined with the Consumer Reports webpages. Accordingly, Claim 12 should be allowed. Claims 13-17 and new Claim 21 should also be allowed for their dependence

on patentable Claim 12 and the additional subject matter recited therein. Claim 21 recites subject matter that was previously presented in Claim 17.

Claim 18 is directed to apparatus for providing user access to electronic images of a physical text based on user ownership of the physical text. The claimed apparatus, in part, includes "means for consulting one or more access rules that define an amount of content in electronic images that can be provided to the user based on the user's ownership of the physical text," which for reasons discussed above with respect to Claim 1, distinguishes the claim over the cited Consumer Reports webpages. In addition, Claim 18 specifies that "the defined amount of content for users who own the physical text is greater than an amount of content that may otherwise be provided to users who do not own the physical text," which is also not shown or suggested in the Consumer Reports webpages, nor is it taught in the Greene, Vellandi, and/or Sachs references.

Claim 18 is therefore patentable over the cited art and should be allowed. Claims 19 and 20 are also patentable for their dependence on allowable Claim 18 and for the additional features they recite.

Lastly, applicants submit that new Claims 22-28 are patentable over the prior art. Claim 22 is directed to a computer-implemented method that includes, in part "processing a request from a user to access an electronic version of a physical work stored in a data storage, wherein the data storage has electronic versions of physical works stored therein, the electronic versions of the physical works comprising images of the physical works that, when displayed to the user, appear the same as the physical works." The Consumer Reports webpages say nothing about the content that is accessible to subscribers of *Consumer Reports Online* and, more to the point, how that content appears to users vis-à-vis the content available in the physical Consumer Reports magazine. Even if the text of articles in Consumer Reports magazine are made available online,

the text is typically formatted differently than in the magazine, with different fonts, different advertising, different placement of advertising, computer links, etc., that take advantage of an interactive online environment. In contrast, Claim 22 states that "the electronic versions of the physical works compris[e] images of the physical works that, when displayed to the user, appear the same as the physical works." At a minimum, this element of Claim 22 is not shown in the cited Consumer Reports webpages, nor is it taught or suggested in the Greene, Vellandi, or Sachs references.

Claim 22 further recites "based on the user's ownership of the physical work, providing the user with access to the electronic version of the physical work." Again, as discussed above, access to an electronic version of a physical work *based on the user's ownership of the physical work* has not been shown in the cited references.

Absent a *prima facie* basis for rejection, Claim 22 should be allowed. Claims 23-28 should also be allowed for their dependence on patentable Claim 22 and for the additional subject matter recited therein.

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CONCLUSION

For the foregoing reasons among others, applicants submit that the pending claims are patentable over the prior art. Applicants respectfully request withdrawal of the rejection of Claims 1-20 and allowance of Claims 1-28 at an early date. Should any issues remain needing resolution prior to allowance, the Examiner is invited to contact the undersigned counsel at the telephone number indicated below.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

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